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92478-8400

AUG 21 2006

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Hiroshi Yahata et al.

Serial No.: 10/561,314

Filed: December 19, 2005

For: RECORDING MEDIUM,  
REPRODUCTION APPARATUS,  
RECORDING METHOD, AND  
REPRODUCTION METHOD

Patent Examiner:

Group Art Unit: 2176

August 21, 2006

Costa Mesa, California 92626

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OFFICE OF PETITIONS

PETITION TO MAKE SPECIALVIA FACSIMILE  
1-571-273-8300Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sirs:

This petition to make special is being submitted in accordance with 37 CFR § 1.102(d) in order to accelerate examination of the above-identified application. Submitted below are items (A) through (E) as required pursuant to MPEP § 708.02(VIII):

**A. FEE**

Submitted with this petition to make special is the fee set forth in 37 CFR § 1.17(h).

**B. SINGLE INVENTION**

In the event that the Office determines that all the claims presented are not obviously directed to a single invention, it is hereby submitted that the Applicants will make an election without traverse as a prerequisite to the grant of special status.

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**C. PRE-EXAMINATION SEARCH**

A search report issued by a foreign patent office in a corresponding foreign application having claims of similar scope to the claims currently pending in this application has already been made of record.

**D. COPY OF REFERENCES**

It is noted that the following four references which have already been made of record and which are cited as category "A" references in the foreign search report are deemed most closely related to the subject matter encompassed by the claims:

- JP 2003-513538 corresponding to WO 01/31497 ( hereinafter "Ruben Gonzales")
- JP 2002-533000 corresponding, to WO 00/36600 (hereinafter "De Haan et al.")
- JP 2001-332006 (hereinafter "Shiraishi et al.")
- JP 9-81118 (hereinafter "Ishiguro")

**E. DETAILED DISCUSSION**

Provided next is a detailed discussion which points out, with the particularity required by 37 CFR § 1.111(b) and (c), how the claimed subject matter is patentable over the aforementioned four category "A" references.

One of the objects of the present invention is to provide an interactive control technology for combining an interactive display with a motion picture [see Specification at page 1 (lines 6-12)].

According to one embodiment of the present invention as recited in independent claim 1 of the present application, a recording medium is provided to comprise: a graphics stream which represents an interactive display including a plurality of graphical button materials to be overlaid with a motion picture wherein: the graphics stream includes a plurality of graphics

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data sets each forming a group of graphics data which renders a predetermined state of the graphical button materials; and the plurality of graphics data sets respectively renders different predetermined states of the graphical button materials.

It is submitted that remaining independent claims 5 and 9-11 of the present application similarly recite the aforementioned features.

By providing the aforementioned arrangement of the plurality of graphics data sets for rendering and displaying the graphic button materials, the present invention is able to achieve a smooth and quick rendering of graphical button materials overlayed with a motion picture, thereby providing a very enjoyable interactive experience for a user a watching motion picture [see FIG. 13-17 and Specification page 3 (line 12) – page 4 (line 17)].

It is submitted that the aforementioned features recited in each of independent claims 1, 5 and 9-11, as well as the above described advantages resultant therefrom, are not disclosed or suggested by the four category “A” references, either taken alone or in combination, for at least the following reasons.

The Ruben Gonzales reference discloses providing software playback of streaming video on a low processing/power mobile device such as a general purpose handheld device without the aid of specialized DSP or custom hardware as an object of the invention [see Specification at page 5 (lines 13-17)]. According to the Ruben Gonzales invention, a packet stream may include not only a video packet stream but also a text packet stream, audio packet stream, music packet stream and/or graphics packet streams [see FIG. 1 and Specification at pages 34-35]. The method comprises the steps of combining packet streams into an object which contains control information, placing a plurality of the objects into a data stream, grouping one or more of the data streams in a scene which includes format definition as the initial packet in a sequence of

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packets, and converting the data into a file [see FIGS. 4-6 and Specification at page 38 (line 6) – page 41 (line 27)]. An encoder for executing the method is provided together with a player or decoder for decoding the file, which can be wirelessly streamed to a portable computer device, such as mobile phone or a PDA. Thus, object controls can provide rendering and interactive controls for objects allowing users to control dynamic media composition, such as dictating the shape and content of interleaved video objects, and control of the objects received [see FIG. 12 and Specification at page 51 (line 21) – page 53 (line 5)].

Accordingly, the main object of the Ruben Gonzales invention is quite different from the present invention in that the Ruben Gonzales invention is directed towards providing a high performance and low complexity software video codec for wirelessly connected mobile devices [see Specification at page 5 (lines 18-22)].

The present invention on the other hand is directed towards an interactive control technology for combining an interactive display with a motion picture.

Thus, it is submitted that the Ruben Gonzales reference fails to disclose or suggest a graphics stream which represents an interactive display including a plurality of graphical button materials to be overlayed with a motion picture wherein: the graphics stream includes a plurality of graphics data sets each forming a group of graphics data which renders a predetermined state of the graphical button materials; and the plurality of graphics data sets respectively renders different predetermined states of the graphical button materials, as recited in independent claims 1, 5 and 9-11 of the present application.

The De Haan et al. reference discloses an apparatus for playing back a record carrier having recorded thereon a first stream of data representing in a video item, a second stream of data representing a graphics item and a control program for controlling interactive playback of

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the items [see FIG. 1 and Specification at page 7 (lines 23-29)]. The program recorded on the record carrier has first and second program portions. The first program portion comprises primary data relating to shape properties of a graphics object [see Specification at page 15 (lines 24-25)]. The second program portion is to be executed after the first program portion in case of compliance of user input with a predetermined condition specified in the program. The second program portion specifies a visual feedback in response to the user Input [see Specification at page 16 (lines 8-17)]. Thus, the De Haan et al. apparatus reproduces the record carrier and can enable the Visual feedback upon receiving a user input and a structure of the first/second program is provided to improve a response of feedback of the user input.

Accordingly, unlike the present invention, the De Haan et al. reference is directed towards the purpose of merely providing interactive playback of graphics data and video data contained on a recorded medium according to user input [see FIG. 4 and Specification at page 19 (lines 1-24)], whereas the present invention is directed towards an interactive control technology for combining an interactive display with a motion picture.

It thus submitted that the De Haan et al. reference fails to disclose or suggest a graphics stream which represents an interactive display including a plurality of graphical button materials to be overlayed with a motion picture wherein: the graphics stream includes a plurality of graphics data sets each forming a group of graphics data which renders a predetermined state of the graphical button materials; and the plurality of graphics data sets respectively renders different predetermined states of the graphical button materials, as recited in independent claims 1, 5 and 9-11 of the present application.

The Shiraishi et al. reference discloses a background image capturing system [see Paragraph 54 of Abstract]. More specifically, this reference discloses a system enabling a user to

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utilize desired pictures/images as background images [see Paragraph 57 of Abstract]. The system enables such pictures/images to be captured as part of image reproduced from a DVD-disk and such pictures/images can be displayed as the background image when videos are not being reproduced from the disk either during a standby state prior to the start of the video reproduction or during a stop state [see "Solution" section in Paragraph 57 of Abstract]. Thus, it is quite clear that the purpose and objective of the Shiraishi et al. invention is quite different from that of the presently claimed invention.

Thus, the Shiraishi et al. reference merely discloses an invention directed towards the use of pictures/images as background images either during a standby state or prior to the start of video reproduction. However, this reference fails to disclose or suggest a graphics stream which represents an interactive display including a plurality of graphical button materials to be overlaid with a motion picture wherein: the graphics stream includes a plurality of graphics data sets each forming a group of graphics data which renders a predetermined state of the graphical button materials; and the plurality of graphics data sets respectively renders different predetermined states of the graphical button materials, as recited in independent claims 1, 5 and 9-11 of the present application.

The Ishiguro reference discloses an image control device for improving the processing speed without using a high-speed CPU [see Paragraph 54 of Abstract]. In greater detail, the Ishiguro reference discloses an image control device capable of displaying an object A image of a character which is not changed and object B image of a character which can be changed. A character string alteration processing is disclosed such that the character of the image B is rewritten by changing a character name in a code of the object B image and the character of the image B is deleted by designating a color block in the code as a transparent color code [see

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"Solution" section in Paragraph 57 of Abstract]. Thus, it is quite clear that the purpose and objective of the Ishiguro et al. invention is quite different from that of the presently claimed invention.

Accordingly, it is submitted that the Ishiguro et al. reference fails to disclose or suggest a graphics stream which represents an interactive display including a plurality of graphical button materials to be overlayed with a motion picture wherein: the graphics stream includes a plurality of graphics data sets each forming a group of graphics data which renders a predetermined state of the graphical button materials; and the plurality of graphics data sets respectively renders different predetermined states of the graphical button materials, as recited in independent claims 1, 5 and 9-11 of the present application.

For at least the foregoing reasons, it is submitted that the aforementioned four prior art references cited as category "A" references in the foreign search report, taken either alone or in combination, fail to disclose or suggest a graphics stream which represents an interactive display including a plurality of graphical button materials to be overlayed with a motion picture wherein: the graphics stream includes a plurality of graphics data sets each forming a group of graphics data which renders a predetermined state of the graphical button materials; and the plurality of graphics data sets respectively renders different predetermined states of the graphical button materials, as recited in independent claims 1, 5 and 9-11 of the present application.

#### CONCLUSION

In view of satisfying each of requirements (A) through (E) above, the Examiner is respectfully requested to grant this petition to make special and accelerate examination of this application.

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Moreover, it is submitted that the present invention as recited in independent claims 1, 5 and 9-11, as well as the claims dependent thereon, is clearly allowable and the Examiner is kindly requested to promptly pass this case to issuance.

In the event that the Examiner has any comments or suggestion of a nature to expedite prosecution of this application, the Examiner is kindly requested to contact the Applicants undersigned representative.

It is believed that applicant has satisfied the requirements for the request for Petition to Make Special and if there are any questions with regards to this matter, the undersigned attorney would appreciate a telephone conference and can be reached at the phone number listed below.

I hereby certify that this correspondence is being transmitted via facsimile to the USPTO at 571-273-8300 on August 21, 2006.

Very truly yours,


SNELL & WILMER L.L.P.

By: Sharon Farnus



Signature

Dated: August 21, 2006

  
\_\_\_\_\_  
Joseph W. Price  
Registration No. 25,124  
600 Anton Boulevard  
Suite 1400  
Costa Mesa, CA 92626  
Telephone: (714) 427-7420  
Facsimile: (714) 427-7799